REMARKS

In response to the office action mailed February 12, 2008, Applicants submit the following remarks. Claims 1, 3-24, 26-34, 36-55, 57-61, and 75-86 are presented for examination.

Claims 1, 3-24, 26-34, 36, 40-55, 57-61, and 75-86 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kuris, U.S. Patent 3,565,062 ("Kuris"). However, Kuris fails to disclose a device that includes a probe and transducer that are adapted so that a torsional vibration created along the probe induces a transverse vibration along the probe, as required by claims 1, 3-24, 26-33, and 75-80. Similarly, Kuris fails to disclose a method that includes producing a torsional vibration along a probe that induces a transverse vibration along the probe, as required by claims 34, 36, 40-55, 57-61, and 81-86.

Referring to Kuris' Figs. 4 and 6, which are reproduced below, Kuris discloses a device that includes an ultrasonic motor 41 connected to an energy transmission cable 42 having a tool member 43 at its terminal end. Kuris, col. 5, lines 68-74.

FIG. 4

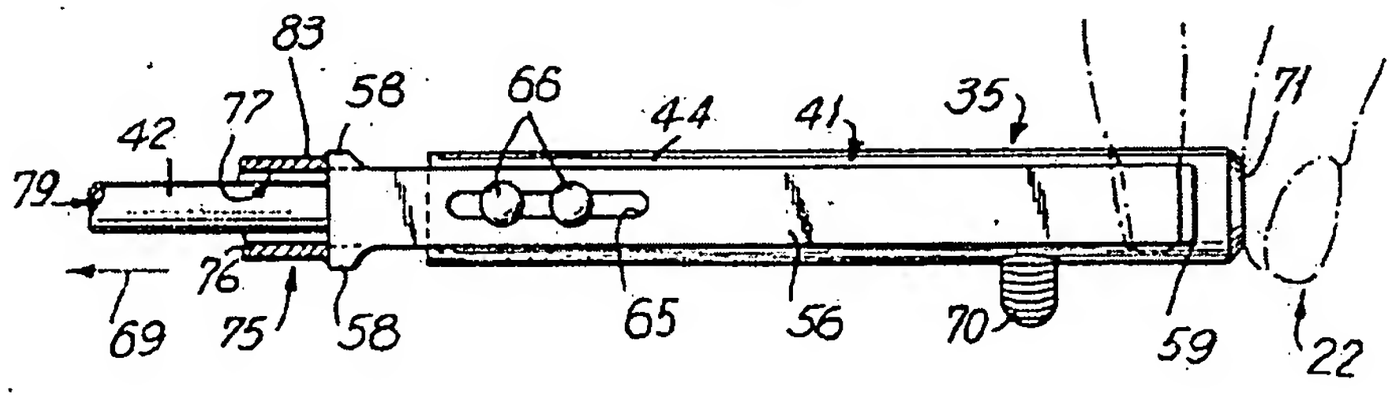
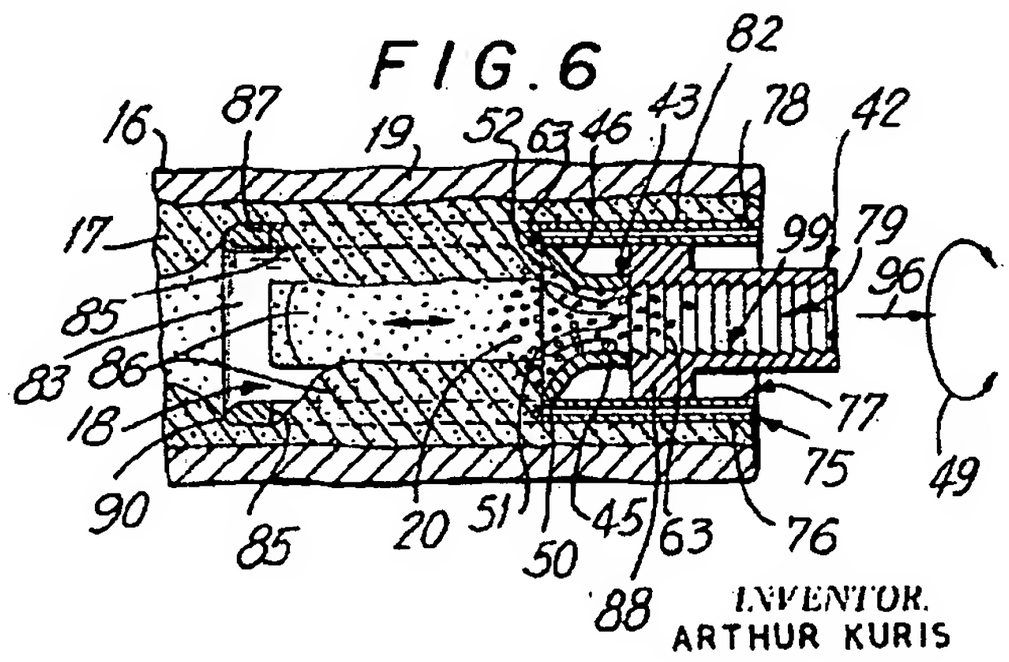


FIG. 6



INVENTOR.
ARTHUR KURIS

The Examiner equates Kuris' ultrasonic motor 41 with Applicants' claimed transducer and equates Kuris' tool member 43 with Applicants' claimed probe. The Examiner takes the position that Kuris' tool member 43 and ultrasonic motor 41 are "capable of being adapted so that the torsional vibration induces a transverse vibration." Office Action mailed February 12, 2008, p. 2. In support of this position the Examiner relies on the following passage of Kuris:

> [T]he active tool output surface enjoys transverse vibration, compressional vibration, flexural vibrations or torsional vibrations or even combinations of said vibrations. For instance, torsional and compressional vibration combined, produce a kind of "corkscrew" vibratory motion, which is particularly suitable for obtaining small foreign deposit samples for biopsy purposes. Kuris, col. 4, lines 44-50.

Even assuming that the above-quoted passage can properly be read as disclosing that Kuris' tool member 43 can be vibrated both torsionally and transversely, which Applicants do not concede, Kuris still does not disclose a probe and transducer that are adapted so that a torsional vibration along the probe induces a transverse vibration along his probe, as required by Applicants' claims 1, 3-24, 26-33, and 75-80. As noted above, the Examiner contends that Kuris' tool member 43 and ultrasonic motor 41 are "capable of being adapted so that the torsional vibration induces a transverse vibration." However, Kuris gives no indication that this is true. Moreover, even assuming that Kuris' tool member 43 and ultrasonic motor 41 are "capable of being adapted so that the torsional vibration induces a transverse vibration," which Applicants do not concede, Kuris certainly does not disclose that his tool member and ultrasonic transducer are adapted so that a torsional vibration along his tool member induces a transverse vibration along his tool member. In fact, throughout Kuris' patent, Kuris does not even mention the idea of using a torsional vibration to induce a transverse vibration along a probe.

Similarly, with regard to claims 34, 36, 40-55, 57-61, and 81-86, Kuris fails to disclose producing a torsional vibration along a probe that induces a transverse vibration along the probe. He provides no disclosure, for example, of producing a torsional vibration along his tool member

that induces a transverse vibration along his tool member. Kuris, as noted above, does not even mention the idea of using a torsional vibration to induce a transverse vibration along a probe.

Moreover, "[i]n order to anticipate, a prior art reference must not only disclose all of the limitations of the claimed invention, but also be enabled." Elan Pharms., Inc. v. Mayo Found., 346 F.3d 1051, 1054 (Fed. Cir. 2003). "A reference is enabled when its disclosures are sufficient to allow one of skill in the art to make and use the claimed invention." Id., 346 F3d at 1054 (quoting Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1374 (Fed. Cir. 2001). Kuris' disclosure would not enable one of ordinary skill in the art to make and use a device including a probe and a transducer that are adapted so that a torsional vibration along the probe induces a transverse vibration along the probe, as required by Applicants' claims 1, 3-24, 26-33, and 75-80. Nor would it enable one of ordinary skill to produce a torsional vibration along a probe that induces a transverse vibration along the probe, as required by claims 34, 36, 40-55, 57-61, and 81-86. As mentioned above, Kuris does not even disclose the idea of using a torsional vibration to induce a transverse vibration along a probe, let alone provide an enabling disclosure for such a feature.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 1, 3-24, 26-34, 36, 40-55, 57-61, and 75-86 as being anticipated by Kuris.

Claims 37-39, 57, and 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuris in view of McCullough (U.S. Patent 6,723,451). Kuris fails to disclose or suggest a method that includes producing a torsional vibration along a probe that induces a transverse vibration along the probe, as required by claims 37-39, 57, and 58. In addition, one of ordinary skill would not have modified the method of use described in Kuris to include this feature of Applicants' claims. McCullough fails to cure these deficiencies of Kuris. In particular, McCullough neither discloses nor suggests a method that includes producing a torsional vibration along a probe that induces a transverse vibration along the probe. Therefore, Applicants request reconsideration and withdrawal of this rejection.

Please apply any charges or credits to deposit account 06-1050, referencing attorney docket number 18554-036001.

Respectfully submitted,

Date: April 11, 2008

Michael R. Hamlin
Reg. No. 54,149

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21859670.doc